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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,351	09/17/2001	Nathan T. Lee	11576.56US01	2171
23552 7590 04/09/2004				
MERCHANT & GOULD PC				
P.O. BOX 2903				
MINNEAPOLIS, MN 55402-0903				
EXAMINER				
THALER, MICHAEL H				
ART UNIT		PAPER NUMBER		
3731				

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

APR 21 2004

TECHNOLOGY CENTER R3700

Office Action Summary

Application No.

09/955,351

Applicant(s)

LEE ET AL.

Examiner

Michael Thaler

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 11, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9, 10, 12-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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Claims 3-8, 11, 17 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8. Contrary to applicant's remarks, claims 5-8 do not read on the elected species. Claims 5-8 read on the species of figure 3 rather than the elected species of figures 8 and 9 since the tapered struts appear in figure 3 but do not appear in figures 8 and 9, noting page 4, lines 28-30 of the specification. Contrary to applicant's remarks, figures 8 and 9 do not show tapered struts.

Claims 1, 10 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wijay (5,824,059). Wijay, in figures 1, 2 and 5, discloses a stent body having a plurality of adjacent circumferential support structures 12, 14, 16, 18 including longitudinal struts and apex portions (for example, all of the ends of the longitudinal struts, including the ends which are attached to strut 46, shown in figure 5 are considered to be apex portions), the apex portions forming junctions between

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adjacent longitudinal struts (i.e., the vast majority of the apex portions form junctions between adjacent longitudinal struts, noting that the claim does not require all of the apex portions to form junctions between adjacent longitudinal struts), some of the apex portions of adjacent circumferential support structures being configured to overlap one another and circumferential connecting struts 40, 42, 46. For example, since circumferential connecting strut 46 extends in a plane which is perpendicular to the longitudinal axis 10, and since the apex portions at each end of strut 46 are considered to include the curved portion at the intersection of strut 46 and the longitudinal strut, the apex portions overlap one another by an amount equal to the thickness of the wire of strut 46. Alternatively, it would have been obvious that the Wijay apex portions overlap one another for the reason set forth above. As to claim 10, the longitudinal struts which are directly connected to the circumferential connecting struts 40, 42, 46 are longer than the other struts by an amount equal to the thickness of the wire of strut 46.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wijay (5,824,059). Wijay, in the embodiment of figures 1, 2 and 5 fails to clearly show adjacent circumferential support structures being offset. However, Wijay, in the embodiments of figures 3 and 4, teaches that adjacent circumferential support structures should be offset such that the apex portions on one side of a support structure are positioned intermediate apex portions on a facing side of an adjacent support structure. This arrangement has the self-evident advantage of providing better support to the blood vessel around its circumference. It would have been obvious to so orient the circumferential support structures of the embodiment of figures 1, 2 and 5 so that it too would have this advantage.

Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Pinchasik et al. (5,449,373). Pinchasik et al. disclose a stent body having a plurality of adjacent circumferential support structures (each of the undulating members which form segments 102 and which are arranged in pairs) including longitudinal struts interconnected at apex portions, and circumferential connecting struts (e.g. 112) interconnecting only some of the adjacent circumferential support structures wherein some pairs of adjacent circumferential support

structures have apex portions that oppose one another (where the apex at the end of one strut 112 is directly opposed to the apex at the end of another strut 112 at the opposite end of the diamond shaped cell 108) and other pairs of adjacent circumferential support structures have apex portions that are offset by the circumferential connecting struts 112 (since the apex portions at each end of each circumferential connecting strut 112 are offset or staggered from each other). That is, the apex portions at each end of each circumferential connecting strut 112 are offset or staggered from each other.

Claims 9 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wijay (5,824,059) in view of Pinchasik et al. (5,449,373). As to claim 9, Wijay fails to disclose the circumferential connecting struts joining first and second support structures extending in a first direction and the circumferential connecting struts joining second and third support structures extending in a second direction. However, Pinchasik et al. teach that the circumferential connecting struts 112 should alternate in their direction in order to minimize rotational displacement of the stent members and the delivery balloon (col. 3, lines 44-51). It would have been obvious to alternate the direction of the Wijay circumferential connecting struts so that it too would have this advantage. As

to claim 13, Wijay fails to disclose circumferential connecting members located between only some of the adjacent pairs of circumferential support structures. However, Pinchasik et al. teach that some of the adjacent pairs of circumferential support structures of a stent should be directly attached to each other (to form cells 108). This arrangement has the self-evident advantage of providing better support to the blood vessel in the area of cells 108. It would have been obvious to so arrange the Wijay circumferential support structures so that it too would have this advantage. As to claim 16, Wijay and Pinchasik et al. fail to disclose three consecutive circumferential support structures being interconnected by circumferential connecting members. However, it was well known in this art to arrange three consecutive circumferential support structures of a stent to be interconnected by circumferential connecting members so that, for example, the numerous connecting members provide flexibility to the stent when being inserted through tortuous blood vessels. It would have been obvious to so arrange the Wijay circumferential support structures so that it too would have this advantage. The above well known in the art statements are taken to be admitted prior art because applicant failed to traverse the examiner's assertions (M.P.E.P. 2144.03).

Applicant's arguments filed Feb. 26+, 2004 have been fully considered but they are not persuasive. The apex portions at the ends of links 112 are not aligned with each other since links 112 extend circumferentially. Thus, these apex portions are circumferentially staggered as claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
4/6/04



MICHAEL THALER
PRIMARY EXAMINER
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NOTICE OF OFFICE PLAN TO CEASE SUPPLYING COPIES OF CITED U.S. PATENT
REFERENCES WITH OFFICE ACTIONS, AND PILOT TO EVALUATE THE
ALTERNATIVE OF PROVIDING ELECTRONIC ACCESS TO SUCH U.S. PATENT
REFERENCES

Summary

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site (www.USPTO.gov) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: http://www.uspto.gov/ebc/registration_pair.html.

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at eReference@uspto.gov or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

Date: 12/1/03

Nicholas P. Godici
Nicholas P. Godici
Commissioner for Patents

